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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85931068
Applicant	TATSU RAMEN LLC
Applied for Mark	TATSU RAMEN WITH A SOUL
Correspondence Address	MICHAEL A. PAINTER ISAACMAN, KAUFMAN & PAINTER 10250 CONSTELLATION BLVD STE 2900 LOS ANGELES, CA 90067-6229 UNITED STATES painter@ikplaw.com, conaway@ikplaw.com
Submission	Request to Suspend the Appeal and Remand the Application for Consideration of Additional Evidence Pursuant to 37 C.F.R. 2.14(d)
Attachments	DOC599.14.1.pdf(320036 bytes)
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Signature	/Michael A. Painter/
Date	05/14/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:
TATSU RAMEN, LLC
Serial No. 85/931,068
For: TATSU RAMEN WITH A SOUL
and Design

APPLICANT'S REQUEST TO SUSPEND THE APPEAL AND
REMAND THE APPLICATION FOR CONSIDERATION
OF ADDITIONAL EVIDENCE PURSUANT TO 37 C.F.R. §2.14(d)

Applicant hereby requests the Board to suspend the pending appeal and remand the application to the trademark examiner for the purpose of allowing the trademark examiner to examine evidence in the form of an agreement consenting to the use and registration of Applicant's service mark, a copy of the agreement being which is attached hereto as Exhibit 1. As set forth in the attached Declaration of Applicant's counsel:

1. Applicant's mark was refused registration on the basis it created a likelihood of confusion with the mark that is the subject of Registration No. 2,234,225;
2. The refusal to register Applicant's mark was made final on October 7, 2013.
3. Subsequent to the issuance of the final refusal to register the Applicant's mark and the date on which the Notice of Appeal was filed, Applicant's counsel unsuccessfully sought to orally and in writing contact the owner of the '225 registration in order to discuss

registrant's consent to Applicant's use and registration of Applicant's service mark.

4. On or about April 10, 2014, a representative of Applicant spoke with Tatsu Arai, President of the Registrant, who agreed to consent to Applicant's use and registration of Applicant's mark. The attached document was prepared and forwarded to Mr. Arai who executed and returned the signed consent agreement on or about May 13, 2014.

Pursuant to 37 C.F.R. §2.142(d), after an appeal is filed, an applicant desiring to introduce additional evidence may request the Board to suspend the Appeal and to remand the application to the trademark examiner for further examination. A request under 37 C.F.R. §2.142(d) must include a showing of good cause in the form of a satisfactory explanation as to why the evidence was not filed prior to the appeal. The length of the delay in making the request to remand the application for further examination will be considered in the determination of whether good cause exists. *TBMP, §1207.02*.

Despite frequent attempts, Applicant was unable to contact the President of the owner of the '225 registration until after the Notice of Appeal was filed. Once Applicant made contact with Tatsu Arai, the Consent Agreement was prepared and executed on May 6, 2014, subsequent to the filing of the Notice of Appeal. The consent agreement was not in existence at the time the Notice of Appeal was filed and therefore is categorized as "new evidence" which was not previously available. *In re Juleigh Jeans Sportswear, Inc.*, 24 U.S.P.Q.2d 1694, 1696, n.4 (TTAB, 1986). As set forth in *Handelman, Guide to TTAB Practice, Volume 2 (2014) at p.30-47*:

"A remand ordinarily will be granted in order to allow the applicant to submit a consent agreement offered in response to a refusal to register under Lanham Act §2(d), 15 U.S.C. 1052(d). The Board recognizes that a consent agreement can be difficult and time-consuming to obtain and may be highly persuasive of


registerability. The Board will grant a request to suspend and remand for consideration of a consent agreement if the request is accompanied by the consent agreement, it is filed at any time prior to the rendering of the Board's final decision on appeal."

It is submitted that Applicant has met all requirements of 37 C.F.R. §2.142(d) and TBMP, §1207.02. On this basis, Applicant's request should be granted and the appeal of the final refusal to register Applicant's mark should be suspended and the pending application remanded to the trademark examiner to review new evidence in the form of the consent agreement.

Respectfully submitted,

ISAACMAN, KAUFMAN & PAINTER, P.C.

By:



Michael A. Painter
Attorneys for Applicant

MAP:Src
Dated: May 14, 2014
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of:
TATSU RAMEN, LLC
Serial No. 85/931,068
For: TATSU RAMEN WITH A SOUL
and Design

DECLARATION OF MICHAEL A. PAINTER

STATE OF CALIFORNIA)
) ss.
COUNTY OF LOS ANGELES)

I, MICHAEL A. PAINTER, do hereby declare and say that:

1. I am the attorney of record for Tatsu Ramen, LLC, the Applicant in the above matter.
2. On October 7, 2013 a Final Office Action was issued refusing registration of Applicant's service mark based upon the registered trademark TATSU'S (Registration No. 2,234,225). On or about November 8, 2013 I advised Applicant of its options to respond to the Final Office Action. Applicant did not believe that its mark created a likelihood of confusion with the cited mark and requested that I attempt to contact the Registrant to discuss this issue and whether the Registrant would consent to the Applicant's use and registration of its service mark.
3. Between December 1, 2013 and March 17, 2014, on numerous occasions I unsuccessfully sought to contact Tatsu Arai, President of Tatsu's, Inc., the owner of the '225 registration. When I was unable to contact Mr. Arai, my client instructed me to file a Notice of Appeal and advised me it would concurrently continue to try to reach Tatsu Arai.
4. On April 10, 2014 I was advised by my client that its representative had contacted Mr. Arai. I was also advised Mr. Arai consented to the use and registration of Applicant's mark and requested that we prepare and forward to him a consent agreement. I prepared the

agreement and forwarded it to my client. A copy of the agreement was executed by Tatsu Arai and was returned to me on May 13, 2014. A copy of the executed agreement consenting to Applicant's use and registration of its service mark is attached hereto.

5. The undersigned, being hereby warned that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §101, and that such willful, false statement may jeopardize the validity of this document, declares that he is properly authorized to execute this document on behalf of the Owner and all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true.

Executed this 14th day of May, 2014 at Los Angeles, California.



MICHAEL A. PAINTER

CONSENT TO USE AND REGISTRATION OF SERVICE MARK

WHEREAS, TATSU'S, INC., is engaged in the rendition of restaurant services and has adopted and is using the service mark TATSU'S for said services and is the owner of Certificate of Registration No. 2,234,225 registered March 23, 1999 in respect of said services in International Class 42; and

WHEREAS, TATSU RAMEN, LLC has, since May 15, 2012, been engaged in the rendition of restaurant services under the service mark TATSU RAMEN WITH A SOUL & Design and has filed an application with the United States Patent and Trademark Office for registration of the service mark TATSU RAMEN WITH A SOUL & Design for said services identified as Application Serial No. 85/931,068 filed May 14, 2013 in International Class 43; and

WHEREAS, TATSU RAMEN, LLC has requested TATSU'S, INC. to consent to use and registration of TATSU RAMEN WITH A SOUL & Design due to its belief that no likelihood of confusion will result from concurrent use and registration of the respective marks as aforesaid; and

WHEREAS, TATSU'S, INC. has considered the request of TATSU RAMEN, LLC and has also determined that no likelihood of confusion will result from the concurrent use and registration of the marks due to the following reasons:

1. The marks are sufficiently different in overall sound, meaning and appearance to enable the public to distinguish the marks.
2. The services rendered by the parties are in totally different geographical regions of the United States and the services rendered are different.
3. As a result of the extensive use of the respective service marks, the public has become sophisticated in the selection of such products and would not be likely to believe

that there is any connection between the trademarks of the parties which have been in concurrent use for over 2 years.

NOW, THEREFORE, for good and valuable consideration, the receipt of and adequacy of which is hereby acknowledged,

TATSU'S, INC. agrees as follows:

1. TATSU'S, INC. perpetually consents to the use and registration by TATSU RAMEN, LLC of the mark TATSU RAMEN WITH A SOUL & Design for the designated goods and registration of said mark for such goods in International Class 43.

2. Based upon its belief that no likelihood of confusion is created by the use of the mark TATSU RAMEN WITH A SOUL & Design for the designated services, TATSU, INC. shall refrain from taking any action or instituting any proceedings, legal or otherwise, which will hinder TATSU RAMEN, LLC in its free and unfettered use of the mark TATSU RAMEN WITH A SOUL & Design for the designated service and registration of same in International Class 43.

3. TATSU'S, INC. agrees that use of the mark TATSU RAMEN WITH A SOUL & Design for the designated services does not conflict with its trademark TATSU'S or Certificate of Registration No. 2,234,225.

Executed this 6 day of MAY, 2014 at Prairie Village, Kansas.

TATSU'S, INC.

By:



TATSU ARAI
President